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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,005	04/27/2001	Joong-Je Park	2050-07	1635

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IPLA P.A.
3580 WILSHIRE BLVD.
17TH FLOOR
LOS ANGELES, CA 90010

EXAMINER

VAN HANDEL, MICHAEL P

ART UNIT	PAPER NUMBER
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2623

MAIL DATE	DELIVERY MODE
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12/29/2006

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/844,005

Applicant(s)

PARK ET AL.

Examiner

Michael Van Handel

Art Unit

2623

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.



**CHRIS KELLEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600**

Continuation of 11.

Applicant's arguments regarding the examiner's introduction of a new ground of rejection, filed 12/01/2006, have been fully considered, but they are not persuasive.

The applicant states that the "applicant presumes that the response to the final rejection had been considered a response to non-final rejection with confusion under complicated file history." The examiner notes that the USPTO's response to the amendment files 6/29/2006 was not mistakenly made based on a complicated file history. The response was made in view of 35 U.S.C. 103, which states that "a patent may not be obtained though invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains..."

The applicant submits that any evidence(s) should be disclosed that led the examiner to a new search. The examiner respectfully disagrees, since the examiner fails to find how such evidence relates to the rejection made under 35 U.S.C. 103(a) over Chaney in view of Park. As stated in the Final Rejection mailed 10/31/2006, the examiner identified a piece of relevant art in a non-related search and decided it necessary to incorporate the art into a new grounds of rejection. Additionally, the examiner notes that it is customary for the Office to perform a search after each response by applicant in order to ensure that newly published references (102(e) references) do not meet claimed limitations.

The applicant further states that "in a customary case ... if the amendment to the final rejection is directed to only allowable claims without new matter issues whatsoever the examiner has to issue a notice of allowance." The examiner respectfully disagrees. M.P.E.P. sections 706.04 and 1308.01 state that a claim noted as allowable shall thereafter be rejected only with the approval of the primary examiner.

Regarding the examiner's introduction of a new ground of rejection, the applicant cites M.P.E.P. 706.07(e), which states: "...Occasionally, the finality of a rejection may be withdrawn in order to apply a new ground of rejection ... Although it is permissible to withdraw a final rejection for the purpose of entering a new ground of rejection, this practice is to be limited to situations where a new reference either fully meets at least one claim or meets it except for differences which are shown to be completely obvious." The applicant further requests evidence of a new ground of rejection in the amendment filed on 6/29/2006. The examiner notes that a new ground of rejection was made in the Non-Final Rejection mailed 7/26/2006, in which the examiner rejected claims 1-3 under Chaney et al. in view of Park and that the examiner rejected claims 6, 7, and 9 under Chaney et al. in view of Cowe and further in view of Park. The examiner notes that none of these rejections had been made prior to this Office Action and were therefore new as of the mailing date 7/26/2006.

The applicant further reminds that the refusal may not be arbitrary or capricious and claims that the application was discriminated. The examiner respectfully disagrees. The examiner reminds the applicant that the new grounds of rejection mailed 7/26/2006 was not arbitrary or capricious, but was made in view of a newly discovered reference the examiner deemed relevant to the application's claim limitations. The examiner apologizes, but maintains that the new grounds of rejection were only made in view of the examiner's responsibility to comply with 35 U.S.C. 103(a).

The applicant further cites M.P.E.P. 706.07(a), which states:

"Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)."

The applicant states that they "failed to find instance(s) of rejections where an amendment seeking only allowable claims and including no information disclosure statements as response to a final rejection was rejected based upon a new search conducted by the examiner's arbitrary decision. The applicant believes that the examiner is subject to proof that the further search was not arbitrary in this case. The examiner notes that a piece of relevant art was identified in a non-related search and the examiner decided it necessary to incorporate the art into a new grounds of rejection. Additionally, the examiner notes that it is customary for the Office to perform a search after each response by applicant in order to ensure that newly published references (102(e) references) do not meet claimed limitations. The examiner submits that the decision to apply the new reference in the new grounds of rejection mailed 7/26/2006 was not arbitrary, but was made in order to comply with the patentability requirements of 35 U.S.C. 103(a).

The applicant disagrees with the examiner's introduction of a new ground of rejection that is not necessitated by the applicant's claim amendment seeking only allowable claims with no arguments; however, the examiner maintains the new grounds of rejection. The examiner identified a piece of relevant art in a non-related search and decided it necessary to incorporate the art into a new grounds of rejection. Since the new grounds of rejection was not necessitated by the applicant's amendment of the claims nor based on information submitted in an information disclosure statement, the examiner made the subsequent action Non-Final in order to conform with M.P.E.P. 706.07(a), which prevents the examiner from making such new grounds of rejection final.

Applicant's arguments regarding claim 1, filed 12/01/2006, have been fully considered, but they are not persuasive.

Regarding claim 1, the applicant argues that the combination of Chaney and Park does not teach the applicant's "outputting a time lapse message when a number of paid digital satellite broadcasting signals is greater than the number of descrambling units." The applicant further argues that there is absolutely nothing in Park to anticipate the applicant's significant comparison and condition of "... a number of paid digital satellite broadcasting signals is greater than the number of descrambling units." The applicant argues still further that the examiner's statement of "inserting a smart card if a smart card is not inserted" has absolutely no connection with the amended claim 1. The examiner respectfully disagrees. Chaney discloses a signal processing system including a first smart card that provides both entitlement processing and descrambling for a first scrambled signal component and a second smart card that provides both entitlement processing and descrambling for a second scrambled signal component (col. 3, l. 17-27, 29-31). Chaney does not disclose outputting a

time-lapse message when a number of paid digital satellite broadcasting signals is greater than the number of descrambling units. Park discloses a satellite broadcasting receiver with a smart card 212 for entitlement processing to determine if a user has an appropriate personal identification number (PIN) for descrambling a scrambled channel signal (col. 3, l. 11, 29-34 & Fig. 2). A controller 206 checks a control bit to determine if a selected channel is scrambled. If scrambled, it checks whether the smart card 212 was inserted. The controller 206 reads a personal identification number (PIN) from the smart card 212 and compares the read information with PIN information pre-stored in a memory 222 (col. 4, l. 34-48). The examiner notes that the smart card 212 is an essential component of the descrambling process of Park. If the smart card is not inserted, the controller applies a control signal to the OSD processor 218 and displays on a display a message requesting the subscriber to insert the smart card 212 (col. 4, l. 39-43). In light of the applicant's specification, stating that a time-lapse message is output when there is no PCMCIA socket for an input signal, and further in light of dependent claim 7, which further limits the time-lapse message limitation of claim 6 by stating "displaying a message that no smart card for descrambling the broadcasting signal is provided when the descrambler is not provided," the examiner finds the message of Park to be the equivalent of applicant's time-lapse message, as currently claimed. Thus, the examiner maintains that Park effectively remedies the deficiencies of Chaney and that it further be obvious to modify Chaney in view of Park in order to provide a more user-friendly interface.